

**Appl. No.** : 10/822,424  
**Filed** : April 12, 2004

### **REMARKS**

Claims 1, 4-7, 13, 14, 16-18, 23-25, 27, and 29-37 were pending prior to the amendments herein. Claims 4, 5, 23-25, 27, and 29-37 are amended herein. Claim 1 has been canceled without prejudice or disclaimer. The Applicants expressly reserve the right to pursue the canceled claim in one or more continuation applications. Claims 4-7, 13, 14, 16-18, 23-25, 27, and 29-37 are therefore pending.

#### **Allowable Subject Matter; Claim Amendments**

The Applicants note with appreciation that Claims 13, 14, 16-18, 37, and 29-34 are allowed and that Claim 35 would be allowable if rewritten in independent form to include all the limitations of the base claim. The Applicants have amended Claim 35 to include all of the features of Claim 1. Additionally, the Applicants have canceled Claim 1 without prejudice or disclaimer, and have amended Claims 4, 5, 23-25, 36, and 37 to depend from Claim 35. The Applicants have also amended Claims 27 and 29-34 to recite the "system" of their respective base claims.

The Applicants respectfully disagree with the statement of reasons for the indication of allowable subject matter to the extent that there is any implication that the patentability of any claim rests on the recitation of a single feature, because the combination of features recited in each claim makes that particular claim patentable.

#### **Response to Rejection Under 35 U.S.C. § 112, ¶ 1**

Claim 1 is rejected under 35 U.S.C. § 112, ¶ 1 for failing to comply with the written description requirement. In particular, the Office Action asserts that the plurality of passages pass through the electrodes, not the isolators, and are partially defined by the isolators, not by the electrodes as recited by Claim 1. To satisfy the written description requirement, the specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. M.P.E.P. § 2163(I), ¶ 2 (citing *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 U.S.P.Q.2d 1895, 1905 (Fed. Cir. 1996)).

The Applicants respectfully submit that Claim 1 and amended Claim 35 are supported in the originally filed specification at least at ¶ [0094], which recites (emphasis added):

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The process solution provides the conductive path that allows current to pass between the contact and process electrodes and the conductive surface. As shown in FIGS. 12A and 12C, the process solution flows through openings 828 provided in the holder structure 804. **The openings** are preferably formed through the contact electrodes 818 and process electrodes 820, although they **may also be opened through the insulating members 822** and the compressible strips 826.

Thus, the Specification explicitly states that the openings may pass through the isolators in embodiments in which the conductive path is provided by the solution. The Applicants submit that it is apparent that the openings through the insulating members 822 may be partially defined by the electrodes in order create a conductive path that contacts the electrodes. Therefore, the Applicants respectfully request that the Examiner withdraw the rejection of Claim 1.

#### **Response to Rejections Under 35 U.S.C. § 103**

Claims 1, 4-7, 23-25, 36, and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,143,155 to Adams et al.

##### Claim 1

The rejection of Claim 1 is moot in light of the cancellation of that claim.

##### Claims 4-7, 23-25, 36, and 37

As described above, amended Claim 35 is allowable. Claims 4-7, 23-25, 36, and 37 depend from Claim 35. Thus, Claims 4-7, 23-25, 36, and 37 include all of the features of amended Claim 35 and recite unique combinations of additional features not taught or suggested by the cited references. Therefore, the Applicants respectfully request that the Examiner withdraw the rejections of Claims 4-7, 23-25, 36, and 37.

#### **Summary**

The Applicants submit that all of the pending claims are allowable, and respectfully request that the Examiner withdraw the rejections and pass Claims 4-7, 13, 14, 16-18, 23-25, 27, and 29-37 to allowance.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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